

III. REMARKS

Claims 1, 4, 21-22, 34-36 and 43-45 are pending in this application. By this Amendment, claims 1 and 44 have been amended. The amendment is being made to facilitate early allowance of the presently claimed subject matter. Applicants do not acquiesce in the correctness of the objections and rejections and reserve the right to present specific arguments regarding any rejected claims not specifically addressed. Further, Applicants reserve the right to pursue the full scope of the subject matter of the original claims in a subsequent patent application that claims priority to the instant application. Reconsideration in view of the above amendments and following remarks is respectfully requested.

Entry of this Amendment is proper under 37 C.F.R. §1.116(b) because the Amendment: (a) places the application in condition for allowance as discussed below; (b) does not raise any new issues requiring further search and/or consideration; and (c) places the application in better form for appeal. Accordingly, Applicants respectfully request entry of this Amendment.

With regard to claim 44, the typographical error noted by the Office has been corrected.

In the Office Action, the revision to the specification, filed 02/04/04, was objected to under 35 U.S.C. §132 for alleged introduction of new matters into the disclosure. Applicants respectfully traverse this objection. Applicants submit that the original specification, particularly FIG. 19 disclosed the features included in the revision to the specification and thus provides antecedent for the revision. Specifically, the left most side of FIG. 19 shows a single insulating layer 24 having a portion that extends on two opposing vertical sides of a second portion of the spacer 16 and contacts the gate electrode 14. See attached photocopy of FIG. 19 for illustration. The second portion of the spacer 16 is the portion that extends upwardly beyond the gate

electrode 14. *See* attached photocopy of FIG. 19 for illustration. Accordingly, Applicants request withdrawal of the objection.

In the Office Action, claims 34-36, 43 and 45 were rejected under 35 U.S.C. 112, first paragraph, as allegedly failing to comply with the written description requirement. Applicants submit that the specification describes the subject matter in those claims in such a way as to reasonably convey to one skilled in the relevant art that Applicants, at the time the application was filed, had possession of the claimed invention, because the specification discloses a single insulating layer 24 having a portion that extends on two opposing vertical sides of a second portion of the spacer 16 and contacts the gate electrode 14, which provides support to claims 34-36, 43 and 45. Applicants request withdrawal of the rejection based on 35 U.S.C. 112, first paragraph.

In the Office Action, claims 1, 4, 21, 22 and 44 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Chittipeddi (PN 6,426,263) in view of Lin et al. (PN 6,083,827); claims 34-36 were rejected under 35 U.S.C. 102(b) as being anticipated by Wei (PN 5,369,303). Applicants submit that the pending claims are allowable for the reasons stated below and thus respectfully request withdrawal of the rejections.

With regard to claim 1, Applicants submit that there is no motivation or suggestion to combine Chittipeddi and Lin. Chittipeddi discloses a method for manufacturing one merged contact in a window. *See* Abstract. Besides the disclosed merged contact, Chittipeddi provides no disclosure about elements adjacent to the disclosed merged contact. How the dielectric deposition (31) contacts potential adjacent elements, if existing, is not addressed in Chittipeddi. *See* FIGS. 9 and 10. So it is incomprehensible why Chittipeddi would like to combine the teaching of Lin et al. regarding the insulation between adjacent gate electrodes. Simply because

Chittipeddi and Lin et al. might work together does not mean that a person having ordinary skill in the art would be motivated to combine them together. Applicants submit that here, only the hindsight teachings of the present invention provide a suggestion to combine. Applicants submit that the Office has failed to show a suggestion or motivation to combine, either in Chittipeddi or in Lin et al. or in the knowledge generally available to one of ordinary skill in the art.

Accordingly, Applicants request withdrawal of the rejection.

In addition, Chittipeddi and Lin et al., even if combinable, do not disclose or suggest each and every claimed feature of the present invention. The present invention includes, *inter alia*, "a masking layer for insulating the first gate electrode from the contact[,]" as recited in claim 1. In Chittipeddi, however, there is no masking layer insulating the gate electrode from the contact and the contact contacts the gate electrode. See FIGS. 9 and 10 of Chittipeddi. Lin et al. do not overcome this deficiency of Chittipeddi, because in Lin et al., the contact (236) contacts gate electrodes (214). See FIGS. 2C, 2D and 2E of Lin et al. Thus the present invention is distinctive to Chittipeddi and Lin et al. and their combination. Accordingly, Applicants request withdrawal of the rejections.

With regard to claim 34, Wei fail to disclose, *inter alia*, "an insulating layer having a portion that extends on two opposing vertical sides of a second portion of the spacer and contacts the gate electrode[,]" as recited in claim 34. Wei discloses an insulating layer 44 that contacts two opposing vertical sides of a spacer 40. See FIG. 9 of Wei. Insulating layer 44, however, does not contact gate electrode 16. *Id.* In Wei, a second insulating layer 32 is positioned between the first insulating layer 44 and the gate electrode 16. *Id.* In contrast, the claimed invention comprises, *inter alia*, an insulating layer that contacts the gate electrode and a masking layer contacting the gate electrode for insulating the gate electrode from the contact. In addition,

even if the insulating layer 44 and 34 of Wei are considered a single layer, there is still no disclosure of "a masking layer contacting the gate electrode for insulating the gate electrode from the contact[.]" as recited in claim 34. In view of the foregoing, Applicants request withdrawal of the rejection of claims 34-36 over Wei.

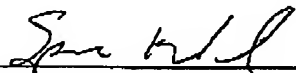
With regard to the Office's response to Applicants' arguments filed 2/4/2004, Applicants note that the Office misunderstood claim 34. In the Office Action, the Office indicated that "Figure 19 [of the present invention] shows the contact (50) contacts the whole side of the spacer (16) so there is no exist [sic] of the insulating layer[.]" See Office Action at page 6. However, Applicants submit that the insulating layer is on the opposite side of the gate electrode 14 in FIG. 19. That is, layer 24 extends on two sides of spacer 16 with masking layer 38 insulating gate electrode 14 from contact 50. Whether contact (50) contacts spacer (16) is not relevant to this feature.

Claims 4, 21 and 44 are dependent upon claim 1, claim 22 is dependent upon claim 21, claims 35, 36 and 45 are dependent upon claim 34, and claim 43 is dependent on claim 35. The dependent claims are believed to be allowable based on the above arguments, as well as for their own additional features.

Applicants respectfully submit that the application is in condition for allowance. Should the Examiner believe that anything further is necessary to place the application in better condition for allowance, he is requested to contact Applicants' undersigned attorney at the telephone number listed below.

Respectfully submitted,

Date: June 2, 2004


Spencer K. Warnick
Reg. No. 40,398

Hoffman, Warnick & D'Alessandro LLC
Three E-Comm Square
Albany, New York 12207
(518) 449-0044
(518) 449-0047 (fax)

10/064,316

9 of 9